REMARKS/ARGUMENTS

Claims 1, 6-13, 15, and 16 were pending in this application, where claims 2-5, 14, and 17-20 were canceled earlier. The present Amendment amends claims 1, 7, 15, and 16 and adds new dependent claims 21-23. Reconsideration and favorable action are respectfully requested.

Rejections Under 35 U.S.C. § 112

The Examiner has rejected claim 1 for insufficient antecedent basis of "the tested device." Claim 1 is amended to change "device" to product, thereby having sufficient antecedent basis from earlier in the claim where the step is recited of "testing a product." Thus, Applicants respectfully request withdrawal of the rejection under Section 112.

Rejections Under 35 U.S.C. § 103

Claims 15 and 16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anecki et al (US 2006/0010377; hereafter, Anecki).

Claim 15 is now amended in various respects. First, the language "operable to" is removed per the Examiner's comments without prejudice or admission. Second, a network is recited in various locations of the claim. Third, the nature of the claims recites that the "product testing specification elements" are "corresponding to a product to be tested." Fourth, the receipt of the waiver request is recited to be "in response to a test of the product." As a result, Applicants respectfully submit that all rejections of claim 15 should now be withdrawn, with certain specific aspects discussed below.

The Examiner rejects claim 15 based on Anecki's document management environment, and appears to give no weight to most if not all of the functional language in claim 15 when interpreting the claim and when comparing it to the prior art under Section 103. Applicants respectfully submit that such language may not be disregarded in such a manner, even more so given the additional amendments to claim 15. Indeed, the Examiner cites to two Federal Circuit cases, and Applicants respectfully note that in *both* of those cases an Examiner was ultimately corrected by the Federal Circuit, where the Examiner had disregarded claim language and the Federal Circuit found first that such language must be viewed in the claim as a whole and second that such language rendered the claimed invention as *not* obvious in view of the prior art.

In one example cited by the Examiner, in *In re Gulack*, 217 USPQ 401 (Fed. Cir. 1983), the invention included a band with printed integers on it,[1] and the prior art *also*

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[1]   *Id*. at 402.

included a band with printed matter on it.[2] The Federal Circuit, in reversing the Examiner's rejection of the claims, found that even though the _sole_ difference between the appealed claims and the prior art was in the content of the printed matter,[3] that the appealed claims were nonetheless patentable. To reach this result, the Federal Circuit examined the *functional relationship* between the printed matter and the rest of the things recited in the claim. As to this relationship, the Court found that in the prior art, the *function* of the text was to help a user of the apparatus with committing things to memory.[4] In contrast, the Court found that in the appealed claims the digits represented a particular sequence that exploit the nature of the band.[5] Thus, it was *entirely the information provided by the text that gave rise to patentability* and the *function* of that information was critical in determining if the claims were patentably distinguishable from the prior art.

In the other example cited by the Examiner, in *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994), the invention included data stored in memory, where the content or information indicated by that data defined a data structure.[6] The Federal Circuit, in reversing the Examiner's rejection of the claims, noted that "printed matter" rejections stand on questionable legal and logical footing and that the data at issue defined *functional characteristics* of the related memory."[7] Specifically, the court said the data bits have "information about relationships" between other data stored in memory[8] and that the Board (and of course the Examiner) were "not at liberty to ignore such limitations."[9] Moreover, the court noted that the recited data structures "perform a function" and that function was not found in the prior art, so the claims were patentable.

Turning now to claim 15, one skilled in the art will readily appreciate from claim 15 as a whole that its *functional relationships*, as required by the Federal Circuit as the basis of proper analysis under Section 103, relate to a product being tested per product testing specification elements and a waiver request (and a response to that request) that relates to that product test. Applicants respectfully submit that express recitations define this functionality in the claim, and neither those recitations nor the *functional relationships they provide are* found in or are obvious from Anecki. Specifically, in claim 15, its recited database is for storing both "a plurality of waiver requests from the waiver requestor and product testing specification elements." There is no teaching in the Examiner's citations in Anecki of "product testing specification elements." Further, amended claim 15 recites that the received waiver request is "in response to a test of the product." There is also no teaching in the Examiner's citations in Anecki that relate to

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2   *Id.* at 404.
3   *Id.*
4   *Id.*
5   *Id.* at 405.
6   *Id.* at 1032.
7   *Id.* at 1034.
8   *Id.*
9   *Id.* at 1035.

this aspect. Thus, Applicants respectfully request withdrawal of the rejection of amended claim 15 and its dependent claim 16.

Claims 1 and 6-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Anecki in view of McKay et al (US 6,418,551, hereafter McKay) and Dallas Semiconductor with a publication date of 5/30/2002 (hereafter Dallas).

Applicants thank the Examiner for acknowledging that "Anecki does not disclose testing a product, initiating and transmitting a request waiver requesting a waiver if a tested device fails an element of the specification, or shipping the device if the plurality of responders approve the document."[10]

However, the Examiner cites to McKay as disclosing testing a product. However, Applicants respectfully submit that one skilled in the art would not at all read McKay to relate to testing a *product* and shipping that *product*. Quite the contrary, as known in the art, "design rule violation" as cited by the Examiner relates to testing a product *design*, not the actual product. Indeed, McKay is full of numerous recitations that makes this clear, where in more details it speaks to characterizing electrical behavior of a circuit "prior to manufacture,"[11] "prior to their manufacture"[12] or "design verification"[13] Thus, Applicants respectfully submit that McKay is not analogous art to which one skilled in the art would look to make the combination of it with Anecki and, hence, the present rejection of claim 1 (and its dependent claims) should be withdrawn.

Further, even if for the sake of argument McKay is considered analogous art, the waiver in McKay is quite different than the waiver-related recitations in claim 1 and therefore a closer examination in claim 1 of each of the times a waiver and its related aspects are recited is not shown in McKay. For example, claim 1 recites not only the "requesting a waiver," but then "sending a notification from the waiver request database via the network *to the plurality of responders, seeking the requested waiver*;" McKay has no counterparts, as it appears to allow the same user that is running the pre-manufacture design check to "automatically" select to waive design rule check violations.[14] Thus, even if the references are combined as suggested by the Examiner, the result does not meet each and every limitation of claim 1 and, hence, the present rejection of claim 1 (and its dependent claims) should be withdrawn.

<u>New Claims</u>

New dependent claims 22-24 are added. No new matter is introduced. For example, antecedent support for claim 21 may be found in the Specification paragraph 1007. Also for example, antecedent support for claim 22 may be found in the

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10	Action, Page 9.
11	McKay, col. 1, line 16.
12	McKay, col. 1, line 29.
13	McKay, col. 1, line 59
14	McKay, col. 2, lines 57-60.

Specification paragraph 1022. And, also for example, antecedent support for claim 23 may be found in the Specification paragraph 1017. None of the aspects of these newly-added claims is shown in the citations provided by the Examiner. Thus, these claims should be in condition for allowance.

Fees

    A Petition for an extension of time of three (3) months is filed herewith. The Commissioner is therefore authorized to charge the extension fee, and any other fees necessary to effect the present filing, to Deposit Account 20-0668 of Texas Instruments Incorporated.

Conclusion

    Applicant respectfully requests that a timely Notice of Allowability be issued in this case.

Respectfully submitted,

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